

REMARKS

Applicants respectfully request entry of the foregoing and reconsideration of the subject matter identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.112, and in light of the remarks which follow.

Applicants thank the Examiner for acknowledging Applicants' claim for foreign priority under 35 U.S.C. § 119 and for indicating that all certified copies of the priority documents have been received. Applicants also thank the Examiner for the Examiner-initialed copies of the PTO Forms 1449 filed with Applicants' Information Disclosure Statements of May 9, 2006, and June 30, 2005. Applicants also thank the Examiner for acknowledging entry and consideration of Applicants' Preliminary Amendment filed on June 30, 2005.

Claims 1-15 are pending in the application.

By the above amendments, Applicants have amended the specification and various claims to address minor informalities and § 112 issues and to place the claims into a more conventional U.S. Patent format. A claim that has been amended in a manner that does not narrow the claim's scope should be accorded its full range of equivalents. Support for these amendments can be generally found in the specification.

Turning now to the Official Action, the specification stands objected to for including various informalities. For at least the reasons that follow, withdrawal of the objection is in order.

Applicants have amended the specification at pages 18 and 24 to address the identified informalities. If the Examiner believes that further clarification is needed,

Applicants would be pleased to consider any further suggested amendments the Examiner wishes to propose.

For at least these reasons, Applicants respectfully request reconsideration and withdrawal of the objection of the specification.

Claims 1-15 stand objected to for including various informalities. For at least the reasons that follow, withdrawal of the objection is in order.

The Official Action objects to claims for including various unnecessary symbols and underlining. Where appropriate, Applicants have attempted to amend the claims to remove such symbols and underlining to obviate the objection. If, however, the Examiner believes that additional amendments are needed to remove informalities, Applicants would be pleased to consider the Examiner's further proposals.

For at least these reasons, Applicants respectfully request reconsideration and withdrawal of the objection to claims 1-15.

Claims 1-15 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. For at least the reasons that follow, withdrawal of the rejection is in order.

The Official Action's § 112, second paragraph, rejection of claims 1-15 is based primarily on the use of a broad range or limitation together with a narrow range of limitation and other claim terminology that the Official Action believes to be indefinite. Applicants have amended the claims where appropriate to attempt to address these issues. Again, however, if the Examiner believes that Applicants have overlooked any issues that can be further clarified, Applicants would be pleased to consider any suggested amendments the Examiner may wish to offer. In those

limited instances where Applicants have not made an amendment in response to an identified issue, Applicants believe that the claim is sufficiently clear to satisfy the requirements of § 112.

For at least these reasons, Applicants respectfully request reconsideration and withdrawal of the § 112, second paragraph, rejection of claims 1-15.

Claims 1-15 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter not adequately described in the specification. For at least the reasons that follow, withdrawal of the rejection is in order.

In particular, concerning claim1 and the language " and/or SM4:or at least one nonreactive (E) POS," Applicants have amended claim 1 and the specification at page 18 to address the issue.

Similarly, with respect to the language "if CA = CA I, then CA I is different from any..." in claim 3, Applicants have amended claim 3 the specification at page 24 to address the issue.

For at least these reasons, Applicants respectfully request reconsideration and withdrawal of the § 112, first paragraph, rejection of claims 1-15.

Claims 1-14 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Jackson (FR 2817262). For at least the reasons that follow, withdrawal of the rejection is in order.

Independent claim1 defines a method for preparing a suspension of a silicic particulate filler, in a silicone material (SM) comprising:

SM₁polyaddition:

at least one type A polyorganosiloxane POS carrying alkenyl crosslinking functional groups *Fa* capable of reacting with crosslinking functional

groups Fb (SiH) of at least one B type POS, this A POS being taken alone or as a mixture with at least one nonreactive (E) POS;

and at least one B type POS carrying crosslinking functional groups Fb (SiH) capable of reacting with the alkenyl crosslinking functional groups Fa of the A POS(s);

and/or SM_2 polycondensation:

at least one C type POS carrying hydroxyl crosslinking functional groups Fc and/or OR functional groups ($R = C_1-C_{30}$ alkyl, C_2-C_{30} alkenyl, aryl, which are optionally substituted) precursor of functional groups Fc' , these crosslinking functional groups Fc being capable of reacting with crosslinking functional groups Fc of this C POS or of other C POSs, and with crosslinking functional groups of at least one crosslinking agent D , this C POS being taken alone or as a mixture with at least one nonreactive (E) POS;

and/or SM_3 polydehydrogenocondensation:

at least one C' type POS carrying hydroxyl crosslinking functional groups Fc' and/or OR' functional groups ($R' = C_1-C_{30}$ alkyl, C_2-C_{30} alkenyl, aryl, which are optionally substituted) precursor of the functional groups Fc' , these crosslinking functional groups Fc' being capable of reacting with other crosslinking functional groups Fb' (SiH) of at least one B' type POS, this C' POS being taken alone or as a mixture with at least one nonreactive (E) POS;

and at least one B' type POS carrying crosslinking functional groups Fb' (SiH) capable of reacting with the crosslinking functional groups Fb' OH or OR' of the C' POS(s);

and/or SM_4 :

or at least one nonreactive (*E*) POS;

this suspension being capable of being used in particular for producing compositions which can be crosslinked by polyaddition and/or by polycondensation and/or by dehydrogenocondensation or antifoam silicone compositions;

this method being of the type in which an aqueous suspension of silicic particulate filler is made hydrophobic by treating with at least one halogenated reagent, this treatment comprising a transfer of the silica made hydrophobic into a nonaqueous phase and at least one step for at least partial removal of water;

a compatibilizing agent (CA) being:

CA I (Route I): either selected from silazanes, taken alone or as a mixture with each other;

CA II (Route II): or selected from R^c-substituted halogenosilanes with R^c = hydrogeno, C₁-C₃₀ alkyl, C₂-C₃₀ alkenyl, aryl, and R^c being optionally substituted;

the said method comprising:

1.

according to route I:

la)-- the particulate filler is selected from the group of precipitated silicas,

lb)-- the compatibilizing agent (CA.I) is added in one or more fractions which are identical to or different from each other, to the preparation medium,

lc)-- the mixing of all or part of the SM, of the filler, of water, and of the CA or CAs is optionally partly carried out in the hot state and in such a manner that the quantity of water is such that the weight ratio $r = (\text{water}/\text{water} + \text{silica}) \times 100$ is defined as follows: $40 \leq r \leq 99$,

Id)-- optionally at least some of the water released and of the by-products of the reaction of *CA.I* with *SM* and with the filler are drawn off,

Ie)-- the volatile species are optionally removed,

If)-- and cooled if necessary,

according to route II:

Ila)-- an aqueous silica suspension is prepared or used which comprises:

silica,

water which is optionally acidified,

at least one hydrogen bond stabilizer,

Ilb)-- optionally, part of the silicone material *SM* is incorporated into the aqueous silica suspension obtained at the end of step Ila),

Ilc)-- hydrophobic units formed by $\equiv\text{Si}-(\text{R}^c)_{1 \text{ to } 3}$ with $\text{R}^c = \text{hydrogeno, C}_1\text{-C}_{30}$ alkyl, $\text{C}_2\text{-C}_{30}$ alkenyl, aryl, these groups R^c being optionally substituted, are grafted onto the silica by exposing this silica to halosilane type *CA II* acting as precursors of these units and by allowing the reaction to proceed, optionally while stirring the whole, and optionally in the hot state,

Ild)-- the procedure is carried out such that the transfer of the silica grafted by hydrophobic units, from the aqueous phase to the nonaqueous phase, is carried out,

Ile)-- optionally, at least part of the aqueous phase and of the reaction by-products is drawn off,

Ilf)-- the medium is cooled if necessary,

Ilg)-- optionally, the residual acidity of the nonaqueous phase is washed off,

Ilh)-- the totality or the remainder of the silicone material *SM* is mixed with the filler which is now hydrophobic,

li)-- the residual water is evaporated off,

lj)-- and an oil is recovered which comprises a hydrophobic particulate filler suspension in a crosslinkable silicone material, optionally without ever passing through dried hydrophobic silica,

the routes I and II leading to an oil (or slurry) comprising a suspension of hydrophobic particulate filler in a crosslinkable silicone material;

2. and at least one other compatibilizing agent (CA ///) is used which is chosen from the group consisting of:

(i) POSSs carrying in and/or at the ends of their chains compatibilizing functional groups OR^{III} in which R^{III} independently corresponds to hydrogen or to a radical corresponding to the same definition as given above for R^C ;

(ii) siloxane resins;

(iii) silanes;

(iv) and mixtures thereof;

excluding:

di- or monofunctional low-molecular-weight (optionally less than 1 000 g/mol) siloxanes with hydroxyl ends;

amines;

and surfactants.

(Emphasis added.)

Jackson relates to the preparation of a suspension of precipitated silica in a silicone oil, the suspension being usable for the production of silicones crosslinkable by polyaddition or polycondensation (RTV elastomers). (See Jackson at Abstract.)

The Official Action asserts that the claims in the instant application are anticipated by Jackson because Jackson discloses a method for preparing a suspension of a silica in a silicone material usable for production of silicones (SM) crosslinkable by polyaddition and/or polycondensation where a compatibilizer (CA) such as organosilozanes, etc. can be employed. (See Official Action at page 8). Applicants respectfully disagree.

It is well-established that in order to demonstrate anticipation under 35 U.S.C. § 102, each feature of the claim at issue must be found, either expressly described or under principles of inherency in a single prior art reference. *See, Kalman v. Kimberly-Clark Corp.*, 218 USPQ 798 (Fed. Cir. 1983). That is not the case here.

In particular, Applicants submit that Jackson fails to disclose or fairly suggest each feature in the combination of features in the method defined in claim 1. For example, Applicants submit that Jackson does not disclose or fairly suggest a method for preparing a suspension of silicic particulate filler, in a silicone material comprising the claimed combination of features including using at least one other compatibilizing agent (CAIII) chosen from the specific group of agents defined in claim 1. That is, Applicants submit that while Jackson may discuss the possibility that a hydroxylated polyorganosiloxane "oil" could have in its structure a minor amount of siloxane units T and/or Q, this minor amount is always less than 1% by weight. Accordingly, Applicants submit that this is an oil which is linear with the possibility (1% or less) of being branched. Applicants submit that this cannot be considered to be a polyorganosiloxane resin which is primarily made of T and/or Q units with terminal M units. Thus, a resin could be seen as a 3-dimensional structure that is different from a silicone oil which is a linear or almost linear (less than 1% T

and/or Q units). Accordingly, Applicants submit that Jackson does not expressly or inherently describe each feature in the combination of features defined in claim 1.

Applicants also submit that it is worth noting the comparative test data provided in Table 2 of the Examples at page 14, paragraph [0381]. In Table 2, the Preparation 1 is a comparative preparation made with only CAI (HMDZ) and no CAIII. Preparation 7 (an exemplary embodiment according to the claims of the instant application) is a preparation with CAI (HMDZ) and CAIII (α,ω -dihydroxylated polydimethylsiloxane oil) of very low viscosity (4-5 Si per chain). The results in Table 2 show that the addition of CAIII has a significant effect on reducing the consistency of the resulting product. Despite the substantial increase in the silica level, the gradient values are much lower in Preparation 7 (exemplary of the instant claims) than in the comparative Preparation 1. Applicants respectfully submit that this may make it possible to consume less power during the process, which is a significant achievement. Of course, Jackson fails to recognize this.

For at least these reasons, Applicants respectfully submit that claim 1 is patentable over Jackson. The remaining claims depend, directly or indirectly, from claim 1 (or otherwise include substantially all of the features of claim 1) and are therefore also patentable over Jackson for at least the reasons that claim 1 is patentable.

Claims 1-12 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Canpont (WO 00/37549). For at least the reasons that follow, withdrawal of the rejection is in order.

Independent claim 1 is recited above.

Canpont relates to a method for preparing a silica suspension in a silicone

matrix, said suspension capable of being used for producing organopolysiloxanes crosslinkable by polycondensation. (See Canpont at Abstract).

The Official Action asserts that the rejected claims would have been obvious over Canpont because Canpont discloses a method for preparing a suspension of silica in a silicone material including a reactive POS, water, optionally a non-reactive POS to produce silicone compositions that can be cured by polycondensation where a compatibilizer such as organosiloxanes, etc. can be employed. (See Official Action at page 9.) Applicants respectfully disagree.

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all of the claimed features. (See *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).) In addition, "all words in a claim must be considered in judging the patentability of that claim against the prior art." (See *In re Wilson*, 424 F.2d 1382, 1385; 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). (See also M.P.E.P. § 2143.03.) Applicants submit that these requirements have not been met.

In particular, Applicants assert that, like Jackson, Canpont does not disclose or fairly suggest each feature in independent claim 1. In particular, Canpont does not disclose or fairly suggest a method for preparing a suspension of silicic particulate filler, in a silicone material (SM) comprising the claimed combination of features including using at least one other compatibilizing agent (CAIII), as defined in independent claim 1. For example, although Canpont may disclose the possibility of a hydroxylated polyorganosiloxane "oil" having in its structure a minor amount of siloxane units T and/or Q, this amount is always less than 1% by weight. (See the U.S. counterpart of Canpont (U.S. Patent No. 6,462,104 at column 8, lines 3-14.)

Accordingly, this cannot be considered a polyorganosiloxane resin made of mainly T and/or Q units with terminal M units. Thus, the rejection over Canpont also does not reflect a proper consideration of "all words" in claim 1 in judging the patentability of claim 1 and its dependent claims over Canpont.

Further, Applicants submit that the comparative results in Table 2 of the Examples at page 14, paragraph [0381] concerning the properties achieved by using at least one other compatibilizing agent CAIII in the claimed process, are secondary considerations that must be considered. Indeed, the Federal Circuit has determined that evidence of secondary considerations can be the most probative and cogent evidence in the record. It can establish that an invention appearing to have been obvious in view of the prior art was not. (See, *Stratoflex Inc. v. Aeroquip Corp.*, 218 U.S.P.Q. 871, 879 (Fed. Cir. 1983); and *Joy Technologies v. Manbeck*, 17 U.S.P.Q.2d 1257 (D.D.C. 1990).) In the instant Official Action, there is no appreciation in Canpont, alone or in combination with any other evidence identified in the Official Action, of the surprising results obtained by the claimed combination of features. Accordingly, even if the Official Action had established a *prima facie* showing of obviousness which Applicants submit that it has not, the unexpected results achieved by the claimed combination of features would rebut such a showing.

For at least these reasons, claim 1 is patentable over Canpont. The remaining claims depend, directly or indirectly, from claim 1 (or otherwise include substantially all of the features of claim 1) and, therefore, are also patentable over Canpont for at least the reasons that claim 1 is patentable. Reconsideration and withdrawal of the rejection are respectfully requested.

From the foregoing, Applicants earnestly solicit further and favorable action in the form of a Notice of Allowance.

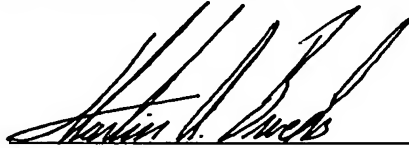
If there are any questions concerning this paper or the application in general, Applicants invite the Examiner to telephone the undersigned at the Examiner's earliest convenience.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: December 5, 2008

By:

A handwritten signature in black ink, appearing to read "Martin A. Bruehs", is written over a horizontal line.

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